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DEPARTMENT OF COMMERCE
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APR 15 1998

APR 13 1998

MAJESTIC, PARSONS,
SIEBERT & HSUE

OFFICE OF PUBLICATIONS
AC PATENTS

James S. Hsue
Majestic Parsons Siebert and Hsue
Four Embarcadero Center, Suite 1100
San Francisco CA 94111-4106

In re Application of
Gross, Altendorfer, Kren, and Marxer
Application No. 08/770,491
Filed: December 20, 1996
For: Process and Assembly for Non-
Destructive Surface Inspections

DECISION ACCORDING STATUS
UNDER 37 CFR 1.47(a) AND
REQUIREMENT OF
SUPPLEMENTAL DECLARATION

This is in response to the "Request for Reconsideration" filed March 9, 1998.

The petition is granted.

Petitioner has now supplied an acceptable declaration under 37 CFR 1.64.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

However, it is noted that the declaration contains a typographical error in the post office and residence address of the non-signing inventor (Liechtenstein is missing a "c"). Accordingly, a supplemental declaration is required, correcting the typographical error, before issuance of the application as a patent or any earlier time required by the examiner.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

The Power of Assignee, filed January 5, 1998, is considered proper for an application filed under 37 CFR 1.47(a).

After mailing this decision, the above-identified application will be forwarded to Group Art Unit 2505 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703)306-3159.

Karin Tyson
Karin Tyson
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

MPS&H FILE #			
MM	PY	MW	
GPP	JPO	BH	
JSS	AOR	MAM	
JSH	VY	GC	g
KN	NEM	MD	



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Norbert Marxer
Mühlegasse 148 FL-9486
Schaanwald Liechtenstein

RECEIVED

APR 15 1998

COPY MAILED

MAJESTIC, PARSONS,
SIEBERT & HSUE

APR 15 1998

In re Application of
Gross, Altendorfer, Kren, and Marxer
Application No. 08/770,491
Filed: December 20, 1996

OFFICE OF PETITIONS
AND PATENTS

For: Process and Assembly for Non-Destructive Surface Inspections

Dear Mr. Marxer:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703)305-9285. Requests for information regarding your application should be directed to the File Information Unit at (703)308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703)308-9726 or 1(800)972-6382 (outside the Washington D.C. area).

Karin Tyson
Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

James S. Hsue
Majestic Parsons Siebert and Hsue
Four Embarcadero Center, Suite 1100
San Francisco CA 94111-4106

SUPPLEMENTAL PATENT APPLICATION DECLARATION

(Attorney's Docket No.: TNCR.007US1)

Each of the Applicants named below hereby declares as follows:

1. My residence, post office address and country of citizenship given below are true and correct.

2. I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought in the patent application entitled "PROCESS AND ASSEMBLY FOR NON-DESTRUCTIVE SURFACE INSPECTIONS," Serial No. 08/770,491, filed December 20, 1996, and I have reviewed and understand the contents of the specification, including its claims. I am applying for this patent on behalf of myself and on behalf of the omitted inventor Norbert Marxer.

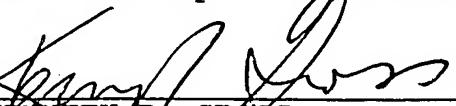
3. I acknowledge my duty to disclose to the Office all information known to me to be material to patentability of this application, in accordance with 37 C.F.R. Section 1.56, which is defined on the attached page.

4. This application is a continuation-in-part of copending application Serial No. 08/533,632, filed September 25, 1995 and of co-pending patent application Serial No. 08/216,834, filed March 24, 1994, now abandoned. I acknowledge my duty to disclose information of which I am aware which is material to the examination of this application, as defined in §1.56, which occurred between the filing date of the prior application and the filing date of this application.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date: _____

Residence and
Post Office Address: NORBERT MARXER
Mühlegasse 148 FL-9486
Schaanwald Liechtenstein
(Citizenship: Liechtenstein)

Date: Feb. 25, 1998 

Residence and
Post Office Address: KENNETH P. GROSS
69 Coronado Avenue
San Carlos, California 94070
(Citizenship: U.S.A.)

Date: Feb 23, 98 

Residence and
Post Office Address: HUBERT ALTENDORFER
324 Meridian Drive
Redwood Shores, California 94035
(Citizenship: Austria)

Date: Feb. 22, 1998 

Residence and
Post Office Address: GEORGE KREN
26685 St. Francis Drive
Los Altos, California 94022
(Citizenship: U.S.A.)

Section 1.56 Duty to Disclose Information Material to Patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

- (i) Opposing an argument of unpatentability relied on by the Office, or
- (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

WASH FILE TNUCR OC 651		
NAME	PY	
APP	WJ	M/W
125	JFO	BH
JSH	ADR	MAM
KN	GLF	GC of



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Majestic Parsons-Siebert and Hsue
Suite 1100
Four Embarcadero Center
San Francisco CA 94111-4106

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DEC 19 1997

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Gross, Altendorfer, Kren, and Marxer
Application No. 08/770,491
Filed: December 20, 1996
For: Process and Assembly for Non-
Destructive Surface Inspections

:
:
: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
:

This is in response to the "Petition to Apply for Patent Under 37 C.F.R. § 1.47(a)," filed September 15, 1997.

The petition is dismissed.

DOCKETED
Rgst Reconsiderat
2/19/98
BH/JB/II SPK

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Failure to respond will result in abandonment of the application. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)" and may include an oath or declaration signed by the previously non-signing inventor.

The above-identified application was filed on December 20, 1996 without either of an executed oath or declaration and the filing fee.

Accordingly, on February 24, 1997, a "Notice To File Missing Parts of Application Filing Date Granted," was mailed, requiring an executed declaration in compliance with 37 CFR 1.63 and the filing fees.

Papers on filed August 25, 1997 in response to the notice included, among other things:

- (1) a Patent Application Declaration signed by joint inventors Gross, Altendorfer, and Kren on behalf of themselves on Norbert Marxer;
- (2) the instant petition under 37 CFR 1.47(a) and the required fees. The petition sets forth the last known address of the non-signing inventor, Norbert Marxer;

- (3) a declaration of facts of James Hsue providing proof that a copy of the application papers was sent to Mr. Marxer and that Mr. Marxer has refused to join in the filing of the above-identified application;
- (4) a declaration of facts of Stanley Stokowski also providing proof that a copy of the application papers was sent to Mr. Marxer and that Mr. Marxer has refused to join in the filing of the above-identified application;
- (5) a declaration of facts of Hubert Altendorfer also providing proof that Mr. Marxer has refused to join in the filing of the above-identified application; and
- (5) a petition for a four month extension of time.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers or proof that the non-signing inventor cannot be reached; (2) an acceptable oath or declaration; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition lacks item (2).

As to item (2), an oath or declaration executed by the available joint inventors on behalf of the non-signing inventor in compliance with 37 CFR 1.63 and 1.64 is required. See 35 U.S.C. § 116, 37 CFR 1.47(a). The declarations do not comply with 37 CFR 1.63 and 1.64 because the residence, post office address and citizenship of the non-signing inventor has been omitted. Accordingly, a supplemental oath or declaration executed by the available inventors on behalf of Mr. Norbert Marxer (and setting forth his last known residence (city and state)), post office address (which can be a business address) and citizenship IS REQUIRED.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: One Crystal Park, Suite 520
 2011 Crystal Drive
 Arlington, VA

Telephone inquiries related to this decision should be directed to the
undersigned at (703) 306-3159.



Karin Tyson
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
NORBERT MARXER ET AL.)
Serial No.: 08/770,491)
Filed: December 20, 1996)
For: PROCESS AND ASSEMBLY FOR)
NON-DESTRUCTIVE SURFACE)
INSPECTIONS)

San Francisco, California

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks, Washington, D.C. 20231 on August 29,
1997.

 8/29/97
Tammy L. Kaplan Date

TRANSMITTAL OF SUPPLEMENTAL DECLARATION BY JAMES S. HSUE

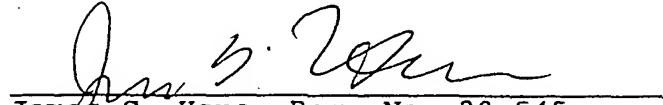
Sir:

A Petition to Apply for Patent Under 37 C.F.R. § 1.47(a) was mailed to the U.S. Patent Office on August 21, 1997. Filed with the Petition was my Declaration indicating that a copy of the application papers had been sent to Dr. Marxer, the inventor who has refused to sign a Declaration for the above-referenced patent application. In my Declaration filed together with the Petition, it was indicated that I invited Dr. Marxer to call me or my secretary in my absence in case he had any questions on this matter, and that if I did not receive the signed Declaration and Assignment from Dr. Marxer by August 23, 1997, I would assume that he was still refusing the Declaration.

My Declaration was signed and mailed to the Patent Office on August 21, 1997, two days before August 23, 1997. The attached Supplemental Declaration by the undersigned supplements my earlier Declaration to clarify that neither I nor my secretary have received any telephone calls or written correspondence or any signed Declaration from Dr. Marxer as of August 23, 1997 and as of the date of this Supplemental Declaration.

Dated: August 29, 1997

Respectfully submitted,



James S. Hsue, Reg. No. 29,545
MAJESTIC, PARSONS, SIEBERT & HSUE
Four Embarcadero Center, Suite 1100
San Francisco, CA 94111-4106
Telephone: (415) 248-5500
Facsimile: (415) 362-5418

Atty. Docket: TNCR.007US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
NORBERT MARXER ET AL.)
Serial No.: 08/770,491)
Filed: December 20, 1996)
For: PROCESS AND ASSEMBLY FOR)
NON-DESTRUCTIVE SURFACE)
INSPECTIONS)

San Francisco, California

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

SUPPLEMENTAL DECLARATION BY JAMES S. HSUE IN SUPPORT OF
PETITION TO APPLY FOR PATENT UNDER 37 C.F.R. § 1.47(a)

Sir:

I, James S. Hsue, hereby declare as follows:

1. As stated in my Declaration in Support of Petition to Apply for Patent Under 37 C.F.R. § 1.47(a) filed on August 21, 1997, in compliance with M.P.E.P. § 409.03(d), a copy of the application papers (specification, including claims, drawings and declaration) were sent by courier to Dr. Norbert Marxer with a transmittal letter (Attachment 1 to my August 21, 1997 Declaration).

2. I stated in my transmittal letter that if I did not receive the signed Declaration or otherwise hear from Dr. Marxer by August 23, 1997, I would assume that he is still refusing to sign the Declaration.

2. As of August 23, 1997 and as of the date of this Supplemental Declaration, neither I nor my secretary have received

the signed Declaration or any telephone calls or written correspondence from Dr. Marxer.

3. I further declare that all statements made on my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any patent resulting therefrom.

Date: Aug. 29, 1997

By:

James S. Hsue

Atty. Docket No. TNCR.007US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
NORBERT MARXER ET AL.)
Serial No.: 08/770,491)
Filed: December 20, 1996)
For: PROCESS AND ASSEMBLY FOR)
NON-DESTRUCTIVE SURFACE)
INSPECTIONS)
) San Francisco, California

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

DECLARATION BY JAMES S. HSUE IN SUPPORT OF
PETITION TO APPLY FOR PATENT UNDER 37 C.F.R. § 1.47(a)

Sir:

I, James S. Hsue, hereby declare as follows:

1. I am patent counsel representing KLA-Tencor Corporation, a company that resulted from a recent merger of KLA Instruments and Tencor Instruments. On December 20, 1996, I mailed the above-referenced application on behalf of Tencor Instruments.

2. In compliance with M.P.E.P. § 409.03(d), a copy of the application papers (specification, including claims, drawings and declaration) was sent by courier to Dr. Norbert Marxer with a transmittal letter. A copy of the transmittal letter is attached as Attachment 1.

3. As stated in the transmittal letter in Attachment 1, if I did not receive the signed Declaration and Assignment from Dr. Marxer by August 23, 1997, I would assume that he is still refusing to sign the Declaration. I invited Dr. Marxer to call me or my

secretary in my absence if he had any questions on this matter. Neither I nor my secretary have received any telephone calls from Dr. Marxer.

4. I further declare that all statements made on my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any patent resulting therefrom.

Date: Aug. 21, 1997 By: James S. Hsue
James S. Hsue

Atty. Docket No. TNCR.007US1

LAW OFFICES OF
MAJESTIC, PARSONS, SIEBERT & HSUE

A PROFESSIONAL CORPORATION

INTELLECTUAL PROPERTY LAW:
PATENTS, TRADEMARKS, COPYRIGHTS,
TRADE SECRETS, AND UNFAIR COMPETITION

FOUR EMBARCADERO CENTER, SUITE 1100
SAN FRANCISCO, CALIFORNIA 94111-4106

SILICON VALLEY OFFICE:
SANTA CLARA, CALIFORNIA

TELEPHONE (415) 248-5500
TELECOPY (415) 362-5418

August 1, 1997

VIA DHL COURIER

Dr. Norbert Marxer
Mühlegasse 148
FL-9486 Schaanwald
Liechtenstein

Re: U.S. Patent Application Serial No. 08/770,491

Inventors: NORBERT MARXER ET AL.

For: "PROCESS AND ASSEMBLY FOR NON-DESTRUCTIVE SURFACE
INSPECTIONS"

Our File No.: TNCR.007US1

Dear Dr. Marxer:

We are patent counsel of KLA-Tencor Corporation. KLA Instruments and Tencor Instruments merged earlier this year, resulting in KLA-Tencor Corporation. As you may know, Tencor Instruments purchased from Censor, patent application Serial No. 08/216,834, filed March 24, 1994, in which you are named as the sole inventor. A continuation-in-part application Serial No. 08/770,491, has been filed claiming priority to Serial No. 08/216,834. In this new application, you and three other individuals are named as co-inventors and the original application Serial No. 08/216,834 is now abandoned. Enclosed is a copy of this new application for your review.

We will need to file a Patent Application Declaration for the new application Serial No. 08/770,491. Enclosed is the Patent Application Declaration and Assignment. We understand that up to now, you have refused to sign the Patent Application Declaration. The final due date for filing the Declaration is August 24, 1997. If no Declaration is filed by such date, the patent application will become abandoned. Therefore, if you have changed your mind and decide to sign the Declaration, please sign the enclosed Declaration and Assignment and return the documents to us before August 24, 1997. If we do not receive the signed Declaration by August 23, 1997, we will assume that you are still refusing to sign the Declaration. If you have any questions on this matter, please call me or my secretary Tammy Kaplan in my absence.

Sincerely,

MAJESTIC, PARSONS, SIEBERT & HSUE


James S. Hsue
EBC.

cc: Stanley Stokowski, Ph.D. (w/formal documents only)
Kevin P. McAndrews, Esq. (w/formal documents only)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
NORBERT MARXER ET AL.)
Serial No.: 08/770,491)
Filed: December 20, 1996)
For: PROCESS AND ASSEMBLY FOR)
NON-DESTRUCTIVE SURFACE)
INSPECTIONS)

San Francisco, California

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

DECLARATION BY STANLEY STOKOWSKI IN SUPPORT OF
PETITION TO APPLY FOR PATENT UNDER 37 C.F.R. § 1.47(a)

Sir:

I, Stanley Stokowski, hereby declare as follows:

1. I am the Chief Scientist in the Wafer Inspection Division of Tencor Instruments at the beginning of 1997. I have the responsibility of overseeing patent applications for the Division.

2. On 22 March 1997, I sent a Patent Application Declaration and Assignment for the above-referenced application to Dr. Norbert Marxer of Liechtenstein.

3. On April 3, 1997, I received a facsimile transmission from Dr. Marxer, a copy of which is attached as Appendix A. As evidenced from the facsimile transmission, Dr. Marxer has refused to sign the Patent Application Declaration that I sent.

4. I further declare that all statements made on my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any patent resulting therefrom.

Date: 8/6/97

By: Stanley Stokowski, Ph.D.
Stanley Stokowski, Ph.D.

Atty. Docket No. TNCR.007US1

FAX

To: Dr. Stan Stokowski
 Chief Scientist
 Wafer Inspection Division
 Tencor Instruments
 Tel:
 Fax: 001-408-571-2900

Hubert

From: Dr. Norbert Marxer
 Mühlegasse 148
 FL-9486 Schaanwald
 Liechtenstein
 Tel: +41-75-3735980
 E-mail: nma@linc.li

April 3, 1997

Dear Dr. Stokowski:

I just received your mail with an Assignment and a Patent Application Declaration, which I should sign.
 Let me give some comments.

Comments to "Patent Application Declaration"

- The address is not quite correct.
 It should read: Mühlegasse 148 street name, house number
 FL-9486 Schaanwald country (short form), postal code (not 9846), village
 Liechtenstein country
- "I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought in the patent application entitled "Process AND" ..., filed December 20, 1996"
 Because I don't know this patent application, I can not sign this declaration.
- "This application is a continuation-in-part of copending application Serial Number 08/533,632, filed September 08/216,834, filed March 24, 1994, now abandoned. I acknowledge my duty to disclose information of which I am aware which is material"
 Because I don't know these two patent applications, I can not sign this declaration.

Comments to "Assignment"

- line 3 it reads Hubert (not Herbert) Altendorfer as far as I remember.
 "Assignors further agree that at the request and expense of Assignee, but without charge to said Assignee, they will promptly execute all papers necessary or desirable ..."
 What does it mean ... expense of Assignee, but without charge to said Assignee ...?
 What does it mean ... promptly ... ? I'm a very busy man and can not always promptly respond.

General comment

I see that the due date is not far away. I do not understand that you contact me so late. Several times in the past I asked your company to send information about the new Tencor machine, which is based on the ANS optics. I never got anything. The same is true for the patent application, where I now get forms to sign without even knowing anything about the history, ... to coauthor a patent which I don't even know.

The question I asked myself. Why should I cooperate and go through all this trouble? Please let me know what you think and how to proceed. To speed up the process, my private E-mail address is nma@linc.li. But do not send attachments, because my software has problems to correctly read them.

Sincerely Norbert Marxer

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
NORBERT MARXER ET AL.)
Serial No.: 08/770,491)
Filed: December 20, 1996)
For: PROCESS AND ASSEMBLY FOR)
NON-DESTRUCTIVE SURFACE)
INSPECTIONS)

San Francisco, California

Hon. Commissioner of
Patents and Trademarks
Washington, D.C. 20231

DECLARATION BY HUBERT ALTENDORFER IN SUPPORT OF
PETITION TO APPLY FOR PATENT UNDER 37 C.F.R. § 1.47(a)

Sir:

I, Hubert Altendorfer, hereby declare as follows:

1. I am an employee of KLA-Tencor Corporation, a company that resulted from a merger of KLA Instruments and Tencor Instruments. The above-referenced application was submitted on behalf of Tencor Instruments.

2. I am one of the inventors in the above-referenced application. On July 30, 1997, I telephoned Dr. Norbert Marxer to inquire whether he would sign the Patent Application Declaration that was forwarded to him by Stanley Stokowski. Dr. Marxer said that he would not sign the Declaration and referred to his initial written response in his facsimile transmission to Mr. Stokowski on April 3, 1997. In the telephone conference Dr. Marxer pointed out several reasons he might have mentioned in his facsimile transmission why he was unwilling to sign the Declaration. First,

he felt that gaining knowledge about patents and patent applications related to the Declaration would take too much of his time. He needed clarification about certain language in the Assignment concerning the expense for executing documents. Dr. Marxer indicated that, due to the filing of the above-referenced application which listed a number of inventors to replace a prior application, he has lost his place as the sole inventor of the prior application. Due to his heavy engagement in his current profession as a politician, Dr. Marxer wants to use his spare time with his family and other private matters, and that the time left aside from his job is too valuable to deal with patent applications and the like, especially if he does not see any personal benefits.

3. I further declare that all statements made on my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any patent resulting therefrom.

Date: August 18, 1997

By: Hubert Altendorfer
Hubert Altendorfer

Atty. Docket No. TNCR.007US1

2001

PATENT APPLICATION DECLARATION
(Attorney's Docket No.: TNCR.007US1)

Each of the Applicants named below hereby declares as follows:

1. My residence, post office address and country of citizenship given below are true and correct.

2. I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought in the patent application entitled "PROCESS AND ASSEMBLY FOR NON-DESTRUCTIVE SURFACE INSPECTIONS," Serial No. 08/770,491, filed December 20, 1996, and I have reviewed and understand the contents of the specification, including its claims. I am applying for this patent on behalf of myself and on the behalf of the omitted inventor Norbert Marxer.

3. I acknowledge my duty to disclose to the Office all information known to me to be material to patentability of this application, in accordance with 37 C.F.R. Section 1.56, which is defined on the attached page.

4. This application is a continuation-in-part of co-pending application Serial Number 08/533,632, filed September 25, 1995 and of co-pending patent application Serial Number 08/216,834, filed March 24, 1994, now abandoned. I acknowledge my duty to disclose information of which I am aware which is material to the examination of this application, as defined in §1.56, which occurred between the filing date of the prior application and the filing date of this application.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date:

8/5/97

Residence and
Post Office Address:
KENNETH P. GROSS
69 Coronado Avenue
San Carlos, California 94070
(Citizenship: United States)

Date:

Aug. 4, 1997

Residence and
Post Office Address:

HUBERT ALTENDORFER

555 West Middlefield Road 94035 324 MERIDIAN DRIVE
Mountain View, California 94031 Redwood Shores,
(Citizenship: United States) (Citizenship: AUSTRIA)

Date:

Aug. 7, 1997

Residence and
Post Office Address:

George Kren

GEORGE KREN
26685 St. Francis Drive
Los Altos, California 94022
(Citizenship: United States)

Section 1.56 Duty to Disclose Information Material to Patentability.

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

(1) prior art cited in search reports of a foreign patent office in a counterpart application, and

(2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

(1) Each inventor named in the application;

(2) Each attorney or agent who prepares or prosecutes the application; and

(3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

**SUPPLEMENTAL
DECLARATION FOR PATENT APPLICATION
AND POWER OF ATTORNEY**

As a below named inventor, I hereby declare that:

COPY

My residence, post office address and citizenship are as stated below adjacent to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of subject matter (process, machine, manufacture, or composition of matter, or an improvement thereof) which is claimed and for which a patent is sought by way of the application entitled

PROCESS AND ASSEMBLY FOR NON-DESTRUCTIVE SURFACE INSPECTIONS

- which (check) is attached hereto.
 and is amended by the Preliminary Amendment attached hereto.
 was filed on December 20, 1996 as Application Serial No. 08/770,491
 and was amended on (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information, which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed:

Prior Foreign Application(s)			Priority Claimed	
Number	Country	Day/Month/Year Filed	Yes	No
N/A			<input type="checkbox"/>	<input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below:

Provisional Application Number	Filing Date
N/A	

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior application(s) in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose information, which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56, which became available between the filing date of the prior application(s) and the national or PCT international filing date of this application:

Application Serial No.	Filing Date	Status (patented, pending, abandoned)
08/533,632	September 25, 1995	Patented
08/216,834	March 24, 199	Abandoned

I hereby appoint the following practitioners to prosecute this application and to transact all business in the United States Patent and Trademark Office connected therewith:

Customer Number 27869

Please address all correspondence and telephone calls to:

James S. Hsue
SKJERVEN MORRILL MacPHERSON LLP
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 San Francisco, California 94111

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 Facsimile: 415-434-0646

I declare that all statements made herein of my own knowledge are true, all statements made herein on information and belief are believed to be true, and all statements made herein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties including fine or imprisonment or both as set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or this document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom.

Full name of sole (or first joint) inventor: NORBERT MARXER

Inventor's Signature: _____ Date: _____

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Post Office Address: Mühlegasse 148 FL-9486 Citizenship: Liechtenstein
 Schaanwald Liechtenstein

Full name of sole (or second joint) inventor: KENNETH P. GROSS

Inventor's Signature: _____ Date: _____

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Full name of sole (or third joint) inventor: HUBERT ALTENDORFER

Inventor's Signature: H. Altendorfer Date: June - 01 - 01

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Full name of sole (or fourth joint) inventor: GEORGE KREN

Inventor's Signature: G. Kren Date: June - 1 - 01

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